

**REMARKS**

***Filing Receipt***

The Applicant filed a Request for Corrected Filing Receipt on April 29, 2002 requesting correction of the Filing Receipt mailed on April 4, 2002. When a Corrected Filing Receipt was not mailed, Applicant filed a second Request for Corrected Filing Receipt on March 12, 2003. Applicant has still not received a Corrected Filing Receipt and, therefore, respectfully requests that one be mailed to the Applicant at the earliest possible date.

***Election/Restrictions***

Applicant has elected to prosecute Group I, Claims 1-10 in the present application. Accordingly, Applicant withdraws Claim 11 but reserves the right to prosecute this claim in a divisional application.

***Claim Objections***

The phrase "can be pulled off same" in Claim 2 has been objected to. Applicant has amended Claim 2 and deleted this phrase.

***Claim Rejections - 35 USC § 112***

Claims 1, 4, 7 and 10 have been rejected under 35 U.S.C. 112, second paragraph. Applicant has amended these claims to overcome the rejections as follows:

Claim 1:

Claim 1 has been amended so that “said surface” is now described as “said siliconised surface.” The phrase “the one/other surface” has been changed to “a first surface” and “a second surface.”

Claim 4:

The references in the Office Action to “a release layer” and “region-wise manner” in the rejections of Claim 4 are unclear. These phrases are not used in the claim and Applicant believes that there was a typographical error. If there was no error, Applicant requests clarification. The phrase “for example a laser or thermal printer” was found to be indefinite. Applicant has deleted this phrase from the claim.

Claim 7:

The references in the Office Action to “a release layer” and “region-wise manner” in the rejections of Claim 7 are unclear. These phrases are not used in the claim and Applicant believes that there was a typographical error. If there was no error, Applicant requests clarification. The phrase containing the term “similar” was found to be indefinite. Applicant has deleted this phrase from the claim.

Claim 1:

The Examiner found that “It is unclear if a release layer is present” since the phrase “which is present only if necessary” is indefinite. Applicant has deleted this phrase and amended

the claim to describe the release layer as “optional.” The phrase “region-wise manner” was found to be indefinite. Applicant deleted this phrase and amended the claim to describe the layer as “at least partially” covering the structure. The phrase, “Possibly a second...adhesive between...” was found to be indefinite. Applicant has deleted this phrase.

***Claim Rejections - 35 USC § 103***

Claims 1-10 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 3,922,435 to Asnes (“Asnes” or “the ‘435 patent”) in view of U.S. Pat. No. 5,962,110 to Penke-Wevelhoff (“Penke-Wevelhoff” or “the ‘110 patent”) in view of U.S. Pat. No. 5,925,431 to Schoenfelder (“Schoenfelder” or “the ‘431 patent”).

The Asnes ‘435 patent discloses “an essentially five layered heat-transfer label” (col. 8, lines 26-48), which has the following structure:

Adhesive Overprint
Design Print
Printed Lacquer
Release Layer
Backing

The Penke-Wevelhoff ‘110 patent discloses transfer images that have “an adherent-melt adhesive” (col. 2, line 11) releasably adhered to a “silicone coated transparent cover paper” (col. 2, lines 14-15). The specification does not clearly describe the structure of the transfer images.

However, the structures are more clearly described in claim 1, which discloses the following layer configuration for the transfer images:

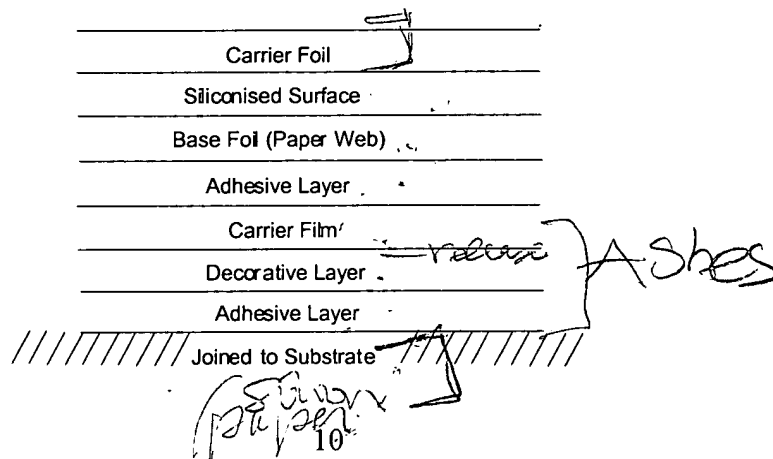
<sp>

Paper
Silicone Coating
Melt Adhesive
Water Based Printing Color
Separating Lacquer Coating
Flexible Paper/Plastic

Penke-Wevelhoff discloses that the transfer image is applied to a substrate by removing the silicone-coated paper to expose the melt adhesive layer and then contacting the exposed melt adhesive to the substrate. (Col. 2, lines 14-19.) (Note, the paper and the silicone coating are shown in the drawing above as separate layers for illustrative purposes.) Thus, Penke-Wevelhoff teaches that the silicone-coated paper is adjacent to the melt adhesive layer which is used to attach the transfer image to a substrate.

In contrast to the structures taught in the Asnes patent and the Penke-Wevelhoff patent, Claim 1 of the present invention discloses the following structure:

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The base foil has a siliconised surface on the side adjacent to the carrier foil so that it is releasably adhered to the carrier foil. (Note, the siliconised surface of the base foil is shown as a separate layer for illustrative purposes.) The surface of the base foil on the side adjacent to the carrier film is not siliconised so that it has good adhesion. (See specification, p. 11, lines 26-31.) This allows the base foil to be easily detached from the carrier foil. The detached base foil and adjoining layers (base foil, adhesive layer, carrier film, decorative layer and adhesive layer) can then be applied to a substrate by contacting the exterior adhesive layer to the substrate. The base foil, adhesive layer and carrier film are then detached from the decorative layer.

The structures of the transfer foils of the present invention are substantially different from the heat-transfer labels and transfer images disclosed in Asnes and Penke-Wevelhoff. This is clearly illustrated when the teachings of Asnes are combined with the teachings of Penke-Wevelhoff as the Office Action suggests. The structure formed by this combination is shown below, along side a structure that corresponds to Claim 1 of the present invention:

Combining Asnes and Penke-Wevelhoff

Paper
Silicone Coating
Adhesive Overprint
Design Print
Printed Lacquer
Release Layer
Backing

The structure of the present invention

Adhesive Overprint
Design Print
Printed Lacquer
Release Layer
Backing
Silicone Coating
Paper

Penke-Wevelhoff teaches a structure wherein the adhesive overprint layer is adjacent to a silicon-coated paper layer. Thus, when the teachings of Penke-Wevelhoff are combined with Asnes, the adhesive overprint layer that is used to adhere the label to a substrate is an internal layer disposed between the backing layer and the silicone-coated layer. Such a structure would not allow printing on the adhesive overprint layer until the silicone-coated layer was detached.

In contrast, the present invention teaches a structure wherein the silicone coating is disposed between the paper layer and the backing (i.e., the base foil and the carrier foil as described in the present invention). Thus, the structures of the present invention allow the outer adhesive layer to be printed prior to the removal of the paper layer (i.e., the carrier foil) while the combination of Asnes and Penke-Wevelhoff would not allow the adhesive layer to be printed until after the silicone-coated paper layer was removed. See specification, p. 11, lines 21-25.

Accordingly, the combination of Asnes and Penke-Wevelhoff would yield a transfer label or transfer image with a layer structure which is substantially different from the present invention. The present invention has the siliconised coating adjacent to the "backing layer" (i.e., the "base foil layer") of the Asnes structure, while Penke-Wevelhoff teaches a structure with the siliconised coating adjacent to the adhesive layer of the Asnes structure. Moreover, there is no teaching or suggestion in either reference which would make it obvious to one of ordinary skill in the art to form a structure with the siliconised layer on the "backing-layer" of the Asnes structure instead of on the "adhesive overprint layer." Therefore, independent Claim 1 and the

other dependent claims of the present invention would not be obvious in view of Asnes and Penke-Wevelhoff.

Claims 2, 3 and 5-7 have also been rejected based on Asnes and Penke-Wevelhoff in view of Schoenfelder which teaches an adhesive label having separate subdivided elements. However, the combination of these three references still does not make Claim 1 of the present invention obvious. The discussion above clearly shows that Claim 1 of the present invention is not obvious in view of a combination of Asnes and Penke-Wevelhoff. The additional combination of the Schoenfelder reference does not cure the deficiencies, and the examiner has not suggested this to be the case. Accordingly, since independent Claim 1 is not made obvious by Asnes and Penke-Wevelhoff in view of Schoenfelder, dependent Claims 2, 3 and 5-7 also are not obvious.

**CONCLUSION**

Applicant believes that the claims as amended are now in the proper form and that the prior art references have been clearly distinguished. Therefore, the Applicant respectfully requests that the claims be allowed.

Respectfully submitted,

A handwritten signature in black ink, reading "Kevin E. McDermott", with a long horizontal flourish extending to the right.

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